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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,183	12/03/2003	Harald Rust	52711-03	2581

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NOVAK DRUCE DELUCA & QUIGG, LLP  
1300 EYE STREET NW  
SUITE 400 EAST  
WASHINGTON, DC 20005

EXAMINER

SHAMEEM, GOLAM M

ART UNIT PAPER NUMBER

1626

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/726,183

Applicant(s)

RUST ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/300,629.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/03/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Priority***

This application is a divisional of 10/300,629 11/21/2002 which is a CIP of 10/207,894 07/31/2002, and the claim of foreign priority under 35 U.S.C. § 119(a)-(d) to Germany 101 376 27.8 08/03/2001 is acknowledged.

### ***Status of Claims***

Claims 10-15 are currently pending in the application. Claims 1-9 were canceled previously.

Receipt is acknowledged of amendment / response filed on June 30, 2005 and that has been entered.

Claim 15 is withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

### ***Response to Election/Restriction***

In response to the restriction requirement, Applicants have elected Group II, which includes claims 10-14 drawn to a process for rectification with traverse is acknowledged. The traversal is on the ground(s) that all the pending claims should be rejoined and examined with the elected Group II because "claim 10 and claim 15 are not mutually exclusive" (Response, page 7) and therefore a search and examination of the entire Application should be made without a serious burden.

Applicant's arguments have been fully considered and found unpersuasive because inventions Groups II and III are although all process claims (process of preparing two different product), yet they are not in the same scope. Inventions are independent if it can be shown that they are not disclosed as capable of use together, having different

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modes of operation, different functions or different effects (MPEP § 806.04, § 808.01). In the instant case the different inventions are drawn to distinct processes of preparing different compounds (final product), requiring different search strategies because of the different reactive steps and conditions involved in each group and to search all the above groups in a single application would be an undue burden on the Examiner. Therefore a separate search considerations are involved, which would impose a burden if unrestricted. Also the fields of search are not coextensive. Additionally, besides performing a class/subclass search, the Examiner performs a commercial data base search and an automated patent system (text) search. Therefore, because of the reasons given above, the restriction set forth is proper and not to restrict would impose a serious burden in the examination of this application. For these reasons, Applicant's arguments are found unpersuasive and, therefore, the requirement for restriction is still deemed proper.

Applicants preserve their right to file a divisional on the non-elected subject matter.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-14 are rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-14 of US 6,900,332 (US

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'332). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter. The process taught by US '332 is similar to instant application because a reference anticipating one set of claim will render the other obvious and it would have been obvious to one of ordinary skill in the art at the time of the invention was made since US '332 teaches the generic process which are similar to the instantly claimed invention. The subject matter claimed in the instant application is fully disclosed and covered in US '332 patent. Therefore, the disclosure of US '332 that teaches all the essential elements to prepare substituted oxazoles (including various reagents and reaction conditions, such as converting continuously added isocyanoalkanoate esters in the presence of cyclizing assistants, and subsequent rectification etc), which would easily place Applicants invention in possession of the public at the time of Applicants invention was filed. Therefore, in the instant case, one skilled in the chemical art would be motivated to modify the reaction conditions (such as, adjusting rectification parameters) to obtain the desired product in view of the known teaching of the art. The claimed process is so closely related methodically as to be analogous process of the reference and therefore obvious in the absence of any unobviousness or unexpected properties. Moreover, any other differences are but obvious technical modifications, which would be apparent to one skilled in the chemical art that can use similar reaction conditions, would expect to have the same or essentially the same results. Therefore, in looking at the instantly claimed process as a whole, the claimed process would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

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*Telephone Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are 571-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read "M. M. Shameem", with a large, stylized initial "M" and "S".

Golam M M Shameem, Ph.D.  
Primary Examiner  
Art Unit 1626  
Technology Center 1600

**GOLAM M. M. SHAMEEM, PH.D**  
**PRIMARY EXAMINER**

July 14, 2005